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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/072,543      | 02/08/2002  | Kevin B. Morton      | NEOMTRX.4C1DV2      | 4228             |

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| EXAMINER |
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FOREMAN, JONATHAN M

|          |              |
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| ART UNIT | PAPER NUMBER |
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3736

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/072,543

Applicant(s)

MORTON ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/03; 8/02; 5/02</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statements filed 5/14/02, 8/28/02 and 1/21/03 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. The information disclosure statements have been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 - 8 of US Patent No. 6,875,184. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because claims 1 and 6 – 8 of US Patent No. 6,875,784 set forth a closed loop system between a plurality of inflatable bladders and a first component. Because the system is a closed recirculation flow path, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the first component acts as a reservoir in that it must accept the excess fluid when the inflatable bladders are not inflated.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4 – 6, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,995,621 to Fletcher et al.

In regards to claims 1, 4 – 6, 11 and 12, Fletcher et al. discloses a closed loop heating system including a plurality of inflatable bladders (20; Figure 3); a reservoir; and a fluid flow path (24, 25) for placing the bladders in fluid communication with the reservoir. The device includes at least 6 inflatable bladders (Col. 3, lines 65 – 67). A heat exchange fluid is contained within the closed loop (Col. 5, lines 8 – 9). The fluid flow path includes a first (24) and second (25) conduit extending between the bladders and the reservoir. Fletcher et al. discloses a mechanical link (Col. 4, lines 4 – 10) between the bladders and a flow path (21) between the bladders.

5. Claims 1- 4, 6, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,507,792 to Mason et al.

In regards to claims 1- 4, 6, 11 and 12, Mason et al. discloses a closed loop heating system including at least 3 inflatable bladders (Figure 1); a reservoir (22); and a fluid flow path for placing

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the bladders in fluid communication with the reservoir. The reservoir comprises a compressible container and has a movable wall (Col. 9, line 54 – Col. 10, line 23). A heat exchange fluid is contained within the closed loop (Col. 6, lines 6 – 11). The fluid flow path includes a first (18) and second (20) conduit extending between the bladders and the reservoir. Mason et al. discloses a mechanical link between the bladders and a flow path between the bladders (Col. 7, line 62 – Col. 8, line 13).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,995,621 to Fletcher et al.

In regards to claims 7 – 19, Fletcher et al. discloses a plurality of inflatable bladders (Figure 3), but fails to disclose the inflated width, length or thickness of the bladder. However, a change in the size of a prior art device is a design consideration within the skill of the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). In the present case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the width, length or thickness of the bladder as disclosed by Fletcher et al. to be any width, length or thickness as desired in order to allow the bladders to conform to breasts of different shapes and sizes.

8. Claims 7 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,507,792 to Mason et al.

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In regards to claims 7 – 19, Mason et al. discloses a plurality of inflatable bladders (Figure 1) having an inflated width, length and thickness (Col. 7, lines 25 – 28) that can be formed to have different sizes and shapes (Col. 8, lines 27 – 50). Although, Mason et al. fails to specifically disclose the inflated width, length or thickness of the bladder. However, a change in the size of a prior art device is a design consideration within the skill of the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). In the present case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the width, length or thickness of the bladder as disclosed by Mason et al. to be any width, length or thickness as desired in order to allow the bladders to conform to a desired surface of the body.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JMLF

  
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